REMARKS

Claims 1-21 are all of the claims presently pending in the application. Claims 1-21 have been merely editorially amended for clarity and have not been amended to more particularly define the invention or to overcome the cited prior art references.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Applicant gratefully acknowledges the Examiner's indication that claims 9, 10, 12, 13, 19 and 21 are allowed.

Regarding claims 11 and 20, Applicant points out that these claims were rejected under 35 U.S.C. § 112, second paragraph, as containing terms that lack proper antecedent basis. Claims 11 and 20 are not subject to a prior art based rejection. Therefore, Applicant assumes that if the 35 U.S.C. § 112, second paragraph, rejection is overcome that claims 11 and 20 would be allowable.

Claim 8 stands rejected under 35 U.S.C. § 102(b) as being anticipated by JP No. 09-46110 to Wataya Masafumi (hereinafter "JP '110"). Claims 1-7 and 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohashi (U.S. Patent No. 5,799,245) in view of JP '110.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as defined by exemplary claim 1) is directed to a portable telephone set including a detector for detecting a better receiving sensitivity one of radio signals received by an exclusive receiving antenna for only receiving radio signals and a transmitting and receiving antenna for transmitting and receiving radio signals, a switch for selecting the radio signal determined in the detector to be the better receiving sensitivity one, and a radio circuit for demodulating the radio signal from the switch (e.g., see Application at page 5, lines 16-25).

The claimed invention (e.g., as defined by exemplary claim 8) is directed to a portable

telephone set including a radio circuit for demodulating a radio signal received by an antenna and transmitted via a cable, and a battery for supplying power to the radio circuit, wherein the battery and the radio circuit are interconnected by the cable, and wherein power from the battery is supplied via the cable to the radio circuit (e.g., see Application at page 8, lines 7-14).

Conventional portable telephone devices use two coaxial cables and a flexible circuit board for connecting and transmitting signals and power between an upper and lower housing of the telephone. The two coaxial cables are used for radio signal transmission between the two housings and the radio signal transmitted through one of the coaxial cables is not actually used for communication, which is undesired from the standpoint of efficient radio signal transmission. In addition, the two coaxial cables increase the size and weight of the telephone. The flexible circuit board is used for supplying power from the battery. This is undesirable because the flexible circuit board is readily affected by externally generated noise.

The claimed invention, on the other hand, provides a portable telephone capable of efficient inter-housing transmission of radio signals (see Application at page 5, lines 12-15). Furthermore, the claimed invention provides a portable telephone set with reduced size and weight (see Application at page 5, lines 9-11).

II. THE 35 USC §112, SECOND PARAGRAPH REJECTION

Claims 7, 11 and 20 stand rejected under 35 U.S.C. §112, second paragraph. The claims have been amended, above, to overcome this rejection. Specifically, the phrase "the cable" has been amended to recite "a coaxial cable" to provide proper antecedent basis for all of the terms in claim 7. Similarly, in claim 11, the phrase "the first or second internal antenna" has been amended to recite "at least one of a first internal antenna and a second internal antenna" to provide proper antecedent basis for all of the terms in claim 11.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. THE REJECTIONS BASED ON PRIOR ART REFERENCES

A. Claim 8

The Examiner alleges that JP '110 teaches the claimed invention of claim 8. Applicant submits, however, that there are elements of the claimed invention which are neither taught nor suggested by JP '110.

That is, JP '110 does not teach or suggest "*a radio signal received by an antenna and transmitted via a cable*" and "*wherein power from the battery is supplied via the cable to the radio circuit*" as recited by claim 8.

The Examiner attempts to rely on Figure 1 of JP '110 to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in Figure 1 (nor anywhere else for that matter) does JP '110 teach or suggest a radio signal received by an antenna and transmitted via a cable, and wherein power from the battery is supplied via the cable to the radio circuit. Indeed, the claimed invention recites a single cable that transmits both a radio signal and power from the battery. This feature is not taught or suggested by JP '110.

JP '110 merely teaches transmitting power from a power supply section (9) through a coaxial cable (32) to a high frequency amplifier (7) (see JP '110 at Abstract).

That is, as best understood, the "radio circuit for demodulating the radio signal" in JP '110 is located in the main body 3 ("...and the amplified signal is fed to a receiver of the telephone set main body 3"). Thus, the configuration shown in JP '110 fails to satisfy the plain meaning of the claim language, since the battery is also located in the main body 3.

If the Examiner wishes, however, to continue to rely on JP '110 for details not expressly stated in the English abstract, it is requested that the USPTO provide a translation and the Examiner point to specific lines in the text of the translation.

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggest by JP '110. Therefore, the Examiner is respectfully requested to withdraw this rejection.

B. Claims 1-7 and 14-18

The Examiner alleges that JP '110 would have been combined with Ohashi to form the claimed invention of claims 1-7 and 14-18. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, these references are directed to different problems and solutions. Specifically, JP '110 is directed to compensating the attenuation due to transmission of a reception signal to the communication equipment without cost increase by connecting a high

frequency amplifier to a reception inclusive antenna, whereas Ohashi is merely directed to providing a radio communication apparatus that employs a space diversity method where antennas are switched both on the receiver and transmitter sides to ensure good data transmission/reception. Therefore, these references are completely unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Moreover, neither JP '110, nor Ohashi, nor any combination thereof, teaches or suggests "*a detector for detecting a better receiving sensitivity one of radio signals received by an exclusive receiving antenna for only receiving radio signals and a transmitting and receiving antenna for transmitting and receiving radio signals*" as recited in claim 1, and similarly recited in claims 2-5.

The Examiner attempts to rely on item 1 in column 8, lines 13-35 and Figure 1 of Ohashi to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor this passage (nor anywhere else for that matter) does Ohashi teach or suggest a detector for detecting a better receiving sensitivity one of radio signals received by an exclusive receiving antenna for only receiving radio signals and a transmitting and receiving antenna for transmitting and receiving radio signals. Indeed, Ohashi does not even mention comparing a receiving sensitivity of an exclusive receiving antenna and a transmitting and receiving antenna.

Ohashi merely teaches that the controller (1) sends the antenna switch signal to the antenna switch circuit (10) to switch the first antenna and second antennas (11 and 12). The first and second antennas can be switched during the transmission/receiving operations when a antenna switch requiring factor occurs, for example, when the same data is re-transmitted on the transmitter side, when a data receiving error occurs on the receiver side or when the data receiving level is low on the receiver side (see Ohashi at column 8, lines 13-43).

Ohashi does not, however, teach comparing the receiving sensitivity of a radio signal received by an exclusive receiving antenna and a transmitting and receiving antenna and detecting which antenna has a better receiving sensitivity.

Moreover, Ohashi is not even directed to a portable telephone set. Ohashi teaches a terminal unit such as a work station (see column 6, lines 43-47 of Ohashi). Also, the antennas in Ohashi are not dedicated to a specific purpose. That is, Ohashi merely teaches a first antenna 11 and a second antenna 12 (see Ohashi at column 7, lines 8-14). Ohashi does not

teach or suggest a transmitting and receiving antenna for transmitting and receiving radio signals, as recited in claim 1. Therefore, the Examiner has clearly failed to make a *prima facie* rejection.

Furthermore, JP '110 does not make up for the deficiencies of Ohashi. That is, JP '110 does not teach or suggest a detector for detecting a better receiving sensitivity one of radio signals received by an exclusive receiving antenna for only receiving radio signals and a transmitting and receiving antenna for transmitting and receiving radio signals. Indeed, the Examiner does not even allege that JP '110 teaches or suggest this feature. In fact, the Examiner merely relies upon JP '110 as teaching an antenna for transmitting and receiving radio signals.

Therefore, Applicant respectfully submits that these references would not have been combined as alleged by the Examiner, and that even if combined, would not teach or suggest each and every feature of the claimed invention.

IV. FORMAL MATTERS AND CONCLUSION

In response to Examiner's objections, the specification has been amended in a manner believed fully responsive to all points raised by the Examiner.

In view of the foregoing, Applicant submits that claims 1-21, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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